

REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the foregoing amendments and the following remarks.

Applicants respectfully thank Examiner Juska for the courtesy she extended in recent telephone interviews with Attorney for Applicants, during which the Final Office Action was discussed and possible claim amendments were considered. No specific agreements concerning the claim language were reached during these telephone interviews.

Claims 113-151 are now pending in the present application, including new independent claims 113, 133, and 146. Independent claim 113, for instance, is directed to a carpet comprising a primary backing and a piling yarn inserted therethrough. The primary backing comprises a composite fibrous material. (See, e.g., Appl. page 5, line 20 – page 6, line 2). This composite fibrous material consists of a woven fabric having warp and fill yarns needlepunched to a bonded nonwoven fabric. The primary backing has a dimensional stability of about 3 pounds to about 20 pounds, where the dimensional stability is determined by grabbing and pulling the backing at a 45 degree angle in relation to the warp and fill yarns of the backing such that the backing incurs approximately a 5% elongation.

In the Final Office Action, independent claims 74, 94, and 107 were rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,242,394 to Leib, et al. Leib, et al. is directed to a reinforced primary backing for tufted pile fabrics, designed to eliminate the need for a secondary backing. (Col. 1, lines 21-27). For example, as shown in the Figure, the reinforced primary backing 4 of Leib, et al. includes a non-woven fibrous capping layer 6, conventionally needled into and through reinforcing material layer 8 and continuing through woven backing layer 10. (Col. 2, lines 33-38). The capping layer 6 can be a layer of any suitable staple fibers. (Col. 2, lines 43-44). The reinforcing material layer 8 can be any suitable natural, semisynthetic, synthetic, or metallic fiber scrim of any suitable weave configuration. (Col. 2, lines 48-51). Also suitable for the reinforcing material layer 8 are spunbonded fibrous sheets. (Col. 2,

lines 58-60). The backing layer 10 can be any conventional woven backing scrim comprising synthetic or natural fibers. (Col. 2, lines 64-65).

As indicated above, Leib, et al. expressly requires the use of three (3) layers to achieve its primary backing—specifically, a capping layer of staple fibers, a reinforcing material layer, and a woven backing layer. To the contrary, new independent claims 113, 133, and 146 each recite a primary backing that comprises a composite fibrous material, where this composite fibrous material “consists of” only two (2) fibrous layers—specifically, a woven fabric and a bonded nonwoven fabric. Thus, although the primary backing of Applicants’ present claims may include other components (such as dyes, sizing agents, and so forth) the claimed primary backing is nevertheless formed from a composite fibrous material consisting of *only 2* fabrics or fibrous layers needlepunched together—not 3. At least because Applicants’ present claims exclude the presence of a third fibrous layer in the primary backing as required by Leib, et al., Applicants respectfully submit that independent claims 113, 133, and 146 are not anticipated by Leib, et al.

In addition, Applicants also respectfully submit that new independent claims 113, 133, and 146 are not obvious in view of Leib, et al. Namely, no motivation would have existed for one of ordinary skill in the art to remove only 1 of the 3 layers of the primary backing of Leib, et al. Leib, et al. repeatedly refers to each layer as forming an integral and necessary part of the primary backing. For instance, Leib, et al. states: “According to this invention, there is provided a reinforced primary backing for tufted pile fabrics comprising a non-woven fibrous capping layer, a reinforcing material layer and a woven backing layer.” (Col. 1, lines 28-31). Leib, et al. further emphasizes that the nonwoven capping layer must be needled into and extend downward through the reinforcing layer and the woven backing layer. (Col. 1, lines 35-40). Thus, a modification of Leib, et al. to remove only 1 of the 3 layers of the primary backing would simply contradict the express teachings of Leib, et al.

Besides failing to disclose or suggest the limitations discussed above, Leib, et al. also fails to disclose or suggest other limitations of independent claims 113, 133, and 146. For instance, each independent claim requires that the primary backing have a

dimensional stability of about 3 to about 20 pounds, where the dimensional stability is determined by grabbing and pulling the backing at a 45 degree angle in relation to the warp and fill yarns of the backing such that the backing incurs approximately a 5% elongation. As correctly noted by the Examiner, Leib, et al. fails to disclose Applicants' claimed dimensional stability. Nevertheless, it was presumed in the Final Office Action that the claimed dimensional stability limitation was inherent in the primary backing disclosed by Leib, et al. Support for this presumption was said to stem from the use of "like materials" and "like processes."

To establish inherency, the evidence must make clear that the missing descriptive matter is *necessarily present* in the reference, and that it would be so recognized by persons of ordinary skill in the art. The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. Thus, an inherency rejection may not be based on what would result due to the optimization of conditions, but only on what was necessarily present in the prior art.

In the present case, a variety of factors may be altered to influence the dimensional stability of Applicants' claimed primary backing, including the types of components utilized, the weight ratio of the components, the needling process, and the like. For example, the amount of needling (e.g., the strokes per minute of the needles, the degree of penetration of the needles, and/or the advance rate of the components) may be adjusted to optimize the strength and adhesion characteristics of the primary backing. (Appl. at pages 11-12). Thus, to obtain Applicants' claimed dimensional stability limitation from the disclosure of Leib, et al., one of ordinary skill would have to select from various possible conditions and parameters. For example, to achieve the dimensional stability required in independent claims 113, 133, and 146, one would have to select the appropriate weight ratios, type of components, needling amounts, and/or other appropriate values. Consequently, Applicants respectfully submit that the claimed dimensional stability limitation does not necessarily flow from the teachings of Leib, et al., nor is Applicants' claimed dimensional stability limitation necessarily present in the primary backing described by Leib, et al.

In summary, Applicants respectfully submit that the present claims patentably define over all of the prior art of record for at least the reasons set forth above. As such, it is believed that the present application is in complete condition for allowance and favorable action, therefore, is respectfully requested. Examiner Juska is invited and encouraged to telephone the undersigned, however, should any issues remain after consideration of this response.

Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

Respectfully requested,

DORITY & MANNING, P.A.



Jason W. Johnston
Registration No. 45,675

Tara E. Agnew
Registration No. 50,589

DORITY & MANNING, P.A.
P. O. Box 1449
Greenville, SC 29602-1449
Phone: (864) 271-1592
Facsimile: (864) 233-7342

Date: Feb. 9, 2004